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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,518	11/12/2003	Albert Paul Pica	SAR 14149	7691

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EXAMINER

CHEN, SHIN HON

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,518

Applicant(s)

PICA ET AL.

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/12/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 14 discloses the key encrypter changes the encrypted broadcast key within the encrypted content is not clearly expressed and examiner cannot find the portion of the specification that describes the process.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 7 recites the limitation "the retrieved content" in line 1 of claim 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6, 9, 10, 12-16, and 18-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ikonen et al. U.S. Pat. No. 6804357 (hereinafter Ikonen).

9. As per claim 1, Ikonen discloses an anti-piracy method comprising: encapsulating a private key in a hardware platform (Ikonen: figure 1 and column 2 lines 50-58: the hardware platform includes both the remote control device and set-top box); requesting content by providing a content request and a public key to a transaction manager (Ikonen: figure 1 and column 2 lines 50-58); obtaining the requested content (Ikonen: column 2 line 63 – column 3 line 14); encrypting the requested content such that the encrypted content can be decrypted using the private key (Ikonen: column 2 line 63 – column 3 line 29); providing the encrypted content to the hardware platform (Ikonen: column 2 line 63 – column 3 line 29) ; and decrypting the encrypted content using the private key to produce a decrypted digital content (Ikonen: column 2 line 63 – column 3 line 29).

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10. As per claim 6, Ikonen as modified discloses the method of claim 1. Ikonen as modified further discloses wherein the requested content is retrieved from memory before encrypting (Ikonen: column 2 line 63 – column 3 line 29).

11. As per claim 9, Ikonen an anti-piracy method comprising: encapsulating a private key in a hardware platform (Ikonen: figure 1 and column 2 lines 50-58: the hardware platform includes both the remote control device and set-top box); requesting broadcast content and providing a content provider with a public key (Ikonen: figure 1 and column 2 lines 50-58); encrypting the broadcast content using a broadcast key such that it can be decrypted using the broadcast key (Ikonen: column 2 line 63 – column 3 line 14); encrypting the broadcast key using the public key such that the broadcast key can be decrypted using the private key (Ikonen: column 2 line 63 – column 3 line 29); sending the encrypted broadcast key and the encrypted broadcast content to the hardware platform (Ikonen: column 2 line 63 – column 3 line 29); decrypting the encrypted broadcast key within the hardware platform using the private key (Ikonen: column 2 line 63 – column 3 line 29); and decrypting the encrypted broadcast content using the decrypted broadcast key (Ikonen: column 2 line 63 – column 3 line 29).

12. As per claim 10, claim 10 encompasses the same scope as claim 1. Therefore, claim 10 is rejected based on the same reason set forth in claim 1.

13. As per claim 12, Ikonen discloses the system of claim 10. Ikonen further discloses wherein the integrated module physically encapsulates the private key (Ikonen: figure 1 and

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column 2 lines 50-58: the hardware platform includes both the remote control device and set-top box).

14. As per claim 13, claim 13 encompasses the same scope as claims 1 and 10. Therefore, claim 13 is rejected based on the reasons set forth in claims 1 and 10.

15. As per claim 14, Ikonen discloses the method of claim 13. Ikonen further discloses wherein the key encrypter changes the encrypted broadcast key within the encrypted content (Ikonen: column 2 line 63 – column 3 line 29).

16. As per claim 15, 16, and 18-23, claims 15, 16, and 18-23 encompass the same scope as claims 1 and 10. Therefore, claims 15, 16, and 18-23 are rejected based on the same reason set forth in claims 1 and 10.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 2-5, 7, 11, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikonen in view of Ogino U.S. Pub. No. 20040107347 (hereinafter Ogino).

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19. As per claim 2, Ikonen discloses the method of claim 1. Ikonen does not explicitly disclose the method further including a step of encoding the requested content before encrypting. However, Ogino discloses watermarking, encoding, and encrypting a data content prior to transmitting to user (Ogino: [0043]-[0044]). It would have been obvious to one having ordinary skill in the art to watermark, encode, and encrypt a content data because data encoding and compression is well known in the art for data communication. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Ogino within the system of Ikonen because it optimizes data transferring.

20. As per claim 3, Ikonen as modified discloses the method of claim 2. Ikonen as modified further discloses the method including converting the decrypted digital content into an analog signal (Ikonen: column 3 lines 15-29).

21. As per claim 4, Ikonen as modified discloses the method of claim 3. Ikonen as modified further discloses wherein said encrypting step comprises watermarking the requested content (Ogino: [0010] and [0043]-[0044]). It would have been obvious to one having ordinary skill in the art to embed user identification watermark into copy protected data. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Ogino within the system of Ikonen because it allows illegally obtained data to be traced.

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22. As per claim 5, Ikonen as modified discloses the method of claim 4. Ikonen as modified further discloses wherein watermarking adds traceable information (Ogino: [0010] and [0043]-[0044]).

23. As per claim 7, Ikonen discloses the method of claim 1. Ikonen does not explicitly disclose wherein the retrieved content is pre-encoded. However, Ogino discloses watermarking, encoding, and encrypting a data content prior to transmitting to user (Ogino: [0043]-[0044]: the data is pre-encoded). It would have been obvious to one having ordinary skill in the art to watermark, encode, and encrypt a content data because data encoding and compression is well known in the art for data communication. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Ogino within the system of Ikonen because it optimizes data transferring.

24. As per claim 11, Ikonen discloses the system of claim 10. Ikonen does not explicitly disclose wherein said integrated module and said manager inter-operatively interact using the Internet. However, Ogino discloses that limitation (Ogino: [0174]). It would have been obvious to one having ordinary skill in the art to interact using the Internet because communications can be achieved in many ways including the Internet, radio communication and many other wired communications. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Ogino within the system of Ikonen because the Internet is a well known method of communicating data.

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25. As per claim 17, Ikonen discloses the integrated module of claim 16. Ikonen implicitly discloses wherein the decrypted bitstream and the decoded digital content are encapsulated (Ikonen: column 3 lines 26-28). Marko explicitly discloses storing the received data (Ogino: [0010]). It would have been obvious to one having ordinary skill in the art to store decrypted and decoded data into a storage means. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Ogino within the system of Ikonen because receiving and storing data allow users to further uses the data.

26. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ikonen in view of Marko et al. U.S. Pat. No. 6876835 (hereinafter Marko).

27. As per claim 8, Ikonen discloses the method of claim 1. Ikonen does not explicitly disclose wherein the encrypted content includes play-limiting instructions. However, Marko discloses a digital broadcast receiver that can store broadcast content files for on-demand playback purposes (Marko: abstract and column 2 lines 37-44). It would have been obvious to one having ordinary skill in the art to store digital data into a receiving device for playback. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Marko within the system of Ikonen because it allows users to play the content anytime he/she desires.

Conclusion

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Chu U.S. Pub. No. 20030016829 discloses system and method for protecting content data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

SC


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